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May 26, 2005

Our File: 2778-157

Commissioner for Trademarks
United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: *American Italian Pasta Company v. Barilla G. E R. Fratelli- Societa Per Azioni*
Opposition No. 91161373

Dear Sirs:

We enclose for filing APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND APPLICANT'S MOTION FOR A UNILATERAL EXTENSION OF DISCOVERY PERIOD.

No fee is believed necessary. The Commissioner for Trademarks is hereby authorized to draw on the deposit account of Rothwell, Figg, Ernst & Manbeck, Account No. 02-2135, if a fee is deemed necessary.

Please call if there are any questions.

Very truly yours,

Carla C. Calcagno

CCC/jea
Enclosure

2778-157
CCC/jea

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN ITALIAN PASTA COMPANY, Opposer v. BARILLA G. E R. FRATELLI- SOCIETA PER AZIONI, Applicant.	)	Opposition No. 91-161,373

APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND APPLICANT'S MOTION FOR A UNILATERAL EXTENSION OF DISCOVERY PERIOD

Applicant, Barilla G.E.R. Fratelli- Società Per Azioni ("Barilla"), hereby opposes Opposer's motion for leave to file an amended Notice of Opposition. Opposer's proposed motion is futile, as the proposed claim fails to state a claim upon which relief can be granted. Secondly, granting Opposer's motion will prejudice Applicant as Opposer failed to seek leave to amend within a reasonable time after knowledge of the facts giving rise to the proposed claim first came to Opposer's attention.

FACTS

On July 21, 2004, Opposer filed its Notice of Opposition. On September 24, 2005, Opposer served its first set of interrogatories and requests for production of documents on Applicant. The parties thereafter granted reciprocal extensions of time. On January 28, 2005, Applicant timely served its discovery responses on Opposer.

On May 6, 2005, fully three months after Applicant served its discovery responses on Opposer, Opposer moved to amend the Opposition, arguing that "the additional grounds for the Opposition set forth in the proposed Amended Notice of Opposition are based on information revealed as the result of discovery responses from Applicant."

ARGUMENT

A. Opposer Fails to State a Claim Upon Which Relief Can Be Granted

Opposer's entire claim states:

> 15. Further, the Applicant, at the time of filing its application, did not have a bona fide intention, under circumstances showing the good faith of such a person, to use the mark in commerce.

In effect, without any proof whatsoever, Opposer is claiming that Applicant fraudulently signed a declaration attesting to its bona fide intention to use the opposed mark in commerce. Clearly, such an allegation is similar to a claim of fraud.

Especially at this late stage, Board precedent mandates that such a claim be supported by a more particular pleading. In *Commodore Electronics Limited v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (TTAB 1993) the Board required the Opposer to state the newly pleaded claim with particularity. The Board noted that Opposer's amendment failed to give Applicant fair notice of why Opposer believed that Applicant lacked a bona fide intent to use. Nonetheless, because the Opposer had, at least in its motion, given the Applicant and the Board some idea as to the factual basis for its claim, the Board allowed the Opposer's motion to amend – contingent on an adequately pleaded claim. In this regard, the Board accepted the claim only when written

as follows:

> "Upon information and belief Applicant did not have a bona fide intent to use the mark in commerce on the specified goods when it filed this and its other applications . . . because Applicant does not have a single document to establish a bona fide intention to use [the mark] in commerce on any of the many goods covered in its various applications to register . . ."

Applicant is entitled to know the facts upon which Opposer bases its startling claim. Opposer has not provided any idea as to the basis of its claim other than vague references to Applicant's discovery responses. Applicant has reviewed its responses and sees absolutely nothing in them that supports Opposer's claim. Here, as in *Commodore,* the Board should not grant Opposer's motion for leave to file an amended Notice of Opposition until the ground is pleaded with greater particularity.

B. Opposer's Motion is Untimely and Will Prejudice Applicant

Opposer waited too long to file its motion. Despite possessing Applicant's discovery responses since January 28, 2005, Opposer waited three months to move to amend the Notice of Opposition. Opposer has not explained this delay.[1]

The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether allowing the proposed amendment will prejudice the adverse party. TMEP Section 507.02(a). As here, a long and unexplained delay in filing a motion to amend a pleading may render the amendment untimely. *Id.* While Opposer argues in

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1 On March 30, 2005, after entry of a protective order, Applicant produced its confidential documents – twelve pages total in number. Applicant has reviewed these documents which consist of Applicant's organizational chart, and detail Applicant's extensive sales volume for its Barilla products in the US. Nothing in those documents possibly relates to a lack of a bona intention to use.

effect that Opposer has newly discovered evidence, Opposer has failed to adequately support this claim. Unlike the Opposer in *Commodore*, Opposer has failed to identify the discovery requests allegedly supporting its claim or even articulate why it believes Applicant lacks a bona fide intention to use. Applicant believes that this is because no facts supporting such a claim exist.

Moreover, as discovery is closing, and since Opposer objects to further extensions, granting Opposer's motion at this stage will prejudice Applicant. Applicant lacks any idea of the basis for Opposer's claim. Applicant is entitled to know the bases for Opposer's claim before it goes to trial.

Board precedent supports Applicant's position. If the motion is granted, precedent mandates that discovery be extended solely for Applicant's benefit to take discovery on the new claim. *See Commodore Electronics Limited v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (TTAB 1993). *Commodore* is directly analogous and binding precedent.

In *Commodore,* as here, the Opposer moved to amend the Notice of Opposition to plead that Applicant lacked a bona fide intention to use the mark. Unlike the Opposer here, the *Commodore* Opposer offered a good reason for the delay. Nonetheless, to remove any prejudice to the Applicant, the Board reopened discovery solely for Applicant's benefit to take discovery on the newly pleaded claim of a lack of a bona fide intention to use.

Indeed, *Commodore* is supported by numerous other Board precedents. Even *Space Base, Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216 (TTAB 1990), cited by Opposer, supports Applicant's, rather than Opposer's, position. In *Space Base,* the Board granted Opposer's motion

subject to a reopening of discovery solely for Applicant's benefit. *See* also TBMP Section 507.02(a), and the numerous cases cited there, which state:

> In order to avoid any prejudice to the adverse party when a motion for leave to amend under Fed. R. Civ. P. 15(a) is granted, the Board may in its discretion, reopen the discovery period to allow the adverse party to take discovery on the matters raised in the amended pleading.

Thus, in the unlikely event that the Board decides to grant Opposer's motion for leave to amend, Applicant respectfully requests that discovery be reopened for 45 days from the Board's order to take discovery on the newly pleaded claim.

CONCLUSION

Wherefore, Applicant respectfully requests that the Board deny Opposer's Motion to Amend. Alternatively, Applicant requests that Opposer's motion be granted contingent upon the filing of a more particularized pleading. After Applicant receives this pleading, the Board should reopen the discovery period for 45 days to take discovery on the newly pleaded claim *solely for Applicant's benefit.*

Respectfully submitted,
Barilla G. E R. Fratelli -
Società Per Azioni

By _____

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND APPLICANT'S MOTION FOR A UNILATERAL EXTENSION OF DISCOVERY PERIOD was served via first-class mail, in a postage prepaid envelope, on counsel for Opposer as follows:**

Thomas H. Van Hoozer, Esq.
Law Offices of Hovey Williams LLP
2405 Grand Boulevard
Suite 400
Kansas City, Mo. 64108-2519

This 26th day of May, 2005.

Joan Adair